No. 22123

UNITED STATES COURT OF APPEALS

For the Ninth Circuit

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SKI POLE SPECIALISTS, INC., a corporation,
Plaintiff-Appellant,

-vs-

ROBERT J. McDONALD,
Defendant-Appellee.

* * * * * *

APPEAL FROM UNITED STATES DISTRICT COURT
DISTRICT OF IDAHO

* * * * * *

APPELLEE'S RESPONSE TO APPELLANT'S SUPPLEMENT TO PETITION FOR REHEARING

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Lloyd J. Webb
RAYBORN, RAYBORN, WEBB & PIKE

P. O. Box 321
Twin Falls, Idaho 83301

ROBERT J. HENRY
SCHAPP & HATCH

155 Montgomery Street
San Francisco, California 94104

Attorneys for Defendant-Appellee

UNITED STATES COURT OF APPEALS

For the Ninth Circuit

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Plaintiff-Appellant,	)	
vs.	)	No. 22123
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Defendant-Appellee.	)	

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Appellee respectfully urges this Court to deny appellant's Petition for Rehearing upon its Supplement to its Petition for Rehearing.

This Court issued its opinion on the 4th day of November, 1968, affirming the Judgment of the United States District Court for the District of Idaho entered April 1967. The opinion of this Court, when commented upon the contention raised by the appellant that the trial court should not have ruled that the appellant was estopped to urge the invalidity of patent 3,193,300, did not rest its decision upon the body

of law applicable to estoppel of a licensee or upon the trial court's determination in that regard, but rather rested its determination upon the lack of jurisdiction under the Federal Declaratory Judgment Act, 28 U.S.C., Sections 2201, 2202 (1964). The Court concluded that there had never been a claim of infringement by the appellee against the appellant, and accordingly the Court simply lacked jurisdiction. This position is not affected one whit by any decision of the trial court in the State of Idaho with reference to the validity or invalidity of the license agreement between the appellee, the appellant, and its predecessor in interest. As this Court correctly commented at page five of its opinion F.2d , :

> "This is not an action to have the license agreement declared invalid, but to have the patent declared invalid. Under the Federal Declaratory Judgment Act, 28 U.S.C., Sections 2201, 2202 (1964), relief can be granted only in 'a case of actual controversy.' Since, as we have held, plaintiff has not been charged with infringement, no actual controversy exists in this statutory sense with respect to the validity of the patent."

The appellee accordingly respectfully suggests that there is no basis for any rehearing or reconsideration of the Court's decision since none of the recent acts of the trial court for the State of Idaho have in any way affected the jurisdictional issue passed upon by this Court in its

opinion, which issue this Court rested upon in its determination. The fact that the United States District Court for the District of Idaho urged both the lack of jurisdiction and the estoppel by license propositions as bases for its decision, it's scarcely significant in view of the fact that this Court has determined that the trial court lacked jurisdiction for the reasons specified and therefore that its decision dismissing the appellant's action should be affirmed.

As concerns the state trial court's decision entered the 18th day of March, 1969, appropriate motions for reconsideration of this decision have been filed by state court counsel for the appellee, and these motions were set for argument on the 28th day of April, 1969. The arguments were heard on that date, but the disposition of the motions is presently unknown to counsel. In any event, appeal time has not expired from the decision of the trial court. 13-201, Idaho Code. The decision of the trial judge can scarcely be taken as a final decision.

The issue of harmony between the state court and the United States Courts as discussed by the United States District Court for the District of Idaho was no part of the opinion decision of this Court and can scarcely be part of a basis

for rehearing of this Court's decision.

It would appear that the final paragraph of the Appellant's Supplement to Petition for Rehearing is an attempt to argue positions which have been twice rejected, once by the trial court and once by this Court and has nothing to do with any recent developments in the state court or in any other tribunal.

The appellee respectfully requests that the appellant's supplemented Petition for Rehearing be denied.

SCHAPP & HATCH
Residing at 155 Montgomery Street
San Francisco, California 94104

RAYBORN, RAYBORN, WEBB AND PIKE
Residing at P. O. Box 321
Twin Falls, Idaho 83301

Attorneys for Appellee

By_____

CERTIFICATE OF SERVICE

A true copy of the foregoing Appellee's Response to Appellant's Supplement to Petition for Rehearing has been sent to Richard W. Seed of Seed, Berry & Dowrey, 1502 Norton Building, Seattle, Washington, 98104, and James B. Donart of Donart & Donart, 32 East Main Street, Weiser, Idaho, 83672, as attorneys for Appellant, by United States mail, postage prepaid this 1st day of May, 1969.

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